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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,421	02/28/2002	Hiroshi Matsuda	03500.016241	7453
5514	7590	09/22/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RUDOLPH. VINCENT M	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/084,421	MATSUDA, HIROSHI
	Examiner	Art Unit
	Vincent M. Rudolph	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 55-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 55-82 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 February 2002 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The amendment filed on 2/13/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the canceling of page 4, lines 5-35 within the specification and adding discrimination means, which is considered by the examiner to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 71-74 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The control program claimed is merely a set of instructions per se. Since the control program is merely a set of instructions not embodied on a computer readable medium to realize the software architecture functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 55-56, 63-64, 71-72 and 75-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 55-56, 63-64, 71-72 and 75-76, the applicant discloses "discriminating whether setting information for a first function of said image processing device is being operated by an operation unit of said image processing device" as well as "discriminating whether setting information for a second function of the image processing device is being operated by said information processing device." According to page 20, lines 15-25, the applicant discloses that "by accessing the device using the Web browser, the function, state, and storage information about the device can be obtained and set using the remote UI, and the device can be operated from a remote place of the image processing device. The information obtained and set by the remote UI are, for example, device information such as an available paper size, the remaining volume, etc., input job information, document information accumulated in the storage device, address information about E-mail, FAX, etc., setting information about a network, etc." Also according to page 27, line 21-page 28, line 4, the applicant discloses that "a person having a card corresponding to a division ID storing a division ID and a password can operate the setting information of the division of the image

processing device. Furthermore, an ID having a privilege as a manager (IT administrator) can similarly be set, and can be managed as one of the division IDs. When a card storing an ID having an IT administrator privilege and a password is input, the setting information about all divisions of the image processing device can be changed." The applicant does not disclose discriminating setting information for a first and second function of the image processing device but rather discloses what the user is able to obtain and set once the device is accessed. Thus, the claimed limitation is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 55, line 7-9 and claim 56, line 4-6, it is not clear what *DISCLOSED STRUCTURE* corresponds to the claimed means.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 55-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan ('070).

Regarding claim 55, Chan ('070) discloses an image processing device (directory server, document store and secure printer, See Figure 1, Element 120, 130 and 140), that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (the device becomes the means), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device (receiving user information prior to processing the document for the intended recipient, Col. 6, Line 7-12), a first discrimination means (the device becomes the means) for deciding whether setting information (user setting information) for a first function of the image processing device is being operated by the operation unit (the directory server operates to receives the data inputted from the user, See Col. 6, Line 9-11). The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request from the information processing device is recognized based on the authentication result by the authentication processing means and the discrimination result (once information to identify the user is recognized, the directory server returns to the computer the public key for the sender, See Col. 6, Line 12-14). The device has a second authentication

processing means (the device becomes the means) that reads information stored on a card (smart card, See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-61), a second discrimination means (the device becomes the means) for discriminating whether setting information for a second function of the image processing device is being operated by the information processing device (in order to discriminate the identity, the computer's operator enters an identification number, See Col. 6, Line 64-67). By doing this, a request from an operation unit within the image processing device is recognized based on the second authentication and the second discrimination result, and thus the image processing device is operable by the operation unit (See Col. 7, Line 1-20).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was accepted. By doing this, the user is better able to verify the genuine recipient of the document so that the document is retrieved at a later time period.

Regarding claim 56, Chan ('070) discloses an image processing device (directory server, document store and secure printer, See Figure 1, Element 120, 130 and 140), that can be connected to an information processing device (a local computer, See Figure 1, Element 100). This device has a first authentication input means (device becomes the means), which is done in response to a request from the information

processing device, for inputting the requested authentication information from the information processing device (receiving the document details and identity of the recipient, See Col. 6, Line 2-14). A second authentication input means (device becomes the means) is performed for inputting authentication information input from an operation unit (smart card, See Figure 1, Element 145), which is inserted into the image processing device (See Col. 6, Line 58-61). This device has an authentication processing means (smart card reader of the secure printer, See Col. 6, Line 58-61) for performing an authenticating process according to the information input from either authentication input means as well as the authentication information in the image processing device (the user inputs the smart card at the image processing device in order to have the identity verified prior to printing, See Col. 6, Line 58-Col. 7, Line 6), a discrimination means (the device becomes the means) for deciding whether setting information (user setting information) for a first function of the image processing device is being operated by the operation unit (the directory server operates to receive the data inputted from the user, See Col. 6, Line 9-11). The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request from the information processing device is recognized based on the authentication result by the authentication processing means and the discrimination result (once information to identify the user is recognized, the directory server returns to the computer the public key for the sender, See Col. 6,

Line 12-14). Whenever the authentication information inputted by the second input means matches an operation on setting information for a second function of the image processing device, (in order to verify the identity, the computer's operator enters an identification number, See Col. 6, Line 64-67), the operation in the operation unit is accepted based on the authentication result (See Col. 7, Line 1-20).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was accepted. By doing this, the user is able to verify the genuine recipient of the document so that it is retrieved at a later time period.

Regarding claim 57, Chan ('070) discloses an image processing device, (directory server, document store and secure printer, See Figure 1, Element 120, 130 and 140), that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (the device becomes the means), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device (receiving user information prior to processing the document for the intended recipient, Col. 6, Line 7-12). The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a

network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). The device has a second authentication processing means (device becomes the means) with an authenticating step by inputting information stored on a card (smart card, See Figure 1, Element 145), which is inserted into the card reader of the image processing device (See Col. 6, Line 58-67). Whenever a request to operate on setting information for a function (operate on setting the selection of the document to output) of the image processing device from the operation unit is accepted based on the authentication result by the second authentication processing means, the request to operate the image processing device from the information processing device is not accepted (since the user has to verify the document information at the printer rather than at the computer prior to printing, See Col. 7, Line 1-20).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was accepted. By doing this, the user is able to verify the genuine recipient of the document so that it is retrieved at a later time period.

Regarding claim 58, Chan ('070) discloses an image processing device (directory server, document store and secure printer, See Figure 1, Element 120, 130 and 140),

that can be connected to an information processing device (local computer, See Figure 1, Element 100). This device has a first authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61), which is done in response to a request from the information processing device (See Col. 5, Line 66-Col. 6, Line 4), for performing the authenticating process according to the request made from the information processing device. The device also includes a display, generated onto a graphical user interface (See Col. 6, Line 4-5) with information transmission means (a network such as a LAN) for transmitting the screen contents for operating the information processing device by supplying information (document details) about the image processing device when a request is authenticated and recognized (See Col. 6, Line 2-14). The device has a second authentication processing means with an authenticating step by reading information stored on a card (smart card, See Figure 1, Element 145), which is inserted into the card reader of image processing device (See Col. 6, Line 58-67). Whenever a request to operate on setting information for a function of the image processing device from the information processing device (submit the document information, See Col. 5, Line 66-Col. 6, Line 7) is accepted based on the authentication result by the first authentication processing means, a request to operate the image processing device from the operation unit is not accepted (since the user has not been verified at the printer prior to selecting the document to output, the operation unit is not operable, See Col. 6, Line 58-67).

Chan ('070) does not disclose transmitting the information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was accepted. By doing this, the user is able to verify the genuine recipient of the document so that it is retrieved at a later time period.

Regarding claim 59, Chan ('070) discloses the first authentication and second authentication processing means perform an authenticating process on the same authentication information (the recipient's identity) as set within the image processing device (to verify this is the same user that wishes to print out the requested document, See Col. 6, Line 58-Col. 7, Line 6).

Regarding claim 60, Chan ('070) discloses an identification information means (the device becomes the means) for issuing identification information (the public key for the intended recipient, Col. 6, Line 12-13) to the information processing device (the local computer, Figure 1, Element 100) when a request from the information processing device is recognized (the user submits a document to be printed, Col. 5, Line 66-Col. 6, Line 2) based on the authentication result (smart card is correctly identified to the intended user, Col. 7, Line 1-7) by the authentication processing means (smart card reader of the secure printer; See Col. 6, Line 58-61). There is also a determination means (device becomes the means) for determining, in response to a request from the information processing device, that the identification information transmitted is added to the request (See Col. 6, Line 4-14). Whenever the determination means determines the identification information is added, the display information transmits the display

information with an authenticating process since the requested information is already sent and this information is to verify the intended recipient (See Col. 6, Line 2-14).

Chan ('070) does not disclose transmitting the identification information from the image processing device to the information processing device.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include transmitting information, such as a message on the display of the information processing device to inform the user the document was accepted. By doing this, the user is able to verify the genuine recipient of the document so that it is retrieved at a later time period.

Regarding claim 61, Chan ('070) discloses the display information can be accessed via the Internet so a user could modify the profile if one wishes to receive documents from one specified printer (See Col. 8, Line 17-29) and the request from the information processing device and the display information are transmitted and received through a network so the information is transmitted to the printer through a protocol (See Col. 7, Line 55-62).

Chan ('070) does not disclose the display information is described in an HTML document as well as transmitted and received according to an HTTP protocol.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the information, when accessed by the Internet, in an HTML document since the majority of information provided over the Internet is viewed as an HTML document and most computers include a browser capable of displaying a HTML document. Also, since information is sent across a network, an HTTP protocol is

needed, such as an IP address, to properly transmit and receive the requested information.

Regarding claim 62, Chan ('070) discloses a conversion means (device becomes the means) for converting the request for authentication input by the first and second authentication input means into a format interpretable by the authentication processing means (a public key is used regarding the intended recipient for the first authentication input, See Col. 6, Line 12-13, and the private key is used as the second authentication for the user in order to retrieve the document, See Col. 6, Line 38-40).

Regarding claims 63-70 and 75-82, the rationale provided in the rejection of claims 55-61 is incorporated herein. In addition, the device of claims 55-61 corresponds to the method of claims 63-70 as well as the device of claims 75-82 and performs the steps disclosed herein.

Regarding claim 71-74, the rationale provided in the rejection of claims 55-58 is incorporated herein. In addition, the device of claims 55-58 corresponds to the control program (See Col. 3, Line 27-30) of claims 71-74 and performs the steps disclosed, respectively.

Response to Arguments

The applicant argues that the prior art does not disclose the first and second discrimination means as well as the conditions for making the image processing device operable. The examiner first points out that the first and second discrimination means are not mentioned anywhere within the specification. Therefore, the examiner interprets that the first discrimination means refer to the directory server, which operates to

receive the data inputted from the user (See Col. 6, Line 9-11), and the second discrimination means refer to the validity of user's identity (See Col. 6, Line 64-67). Thus, once the identity is verified, the printer becomes operable so that the document is able to be retrieved and outputted (See Col. 7, Line 1-20). Thus, the prior art is able to meet the claimed limitations of the amended claims.

As a result, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/18/06

VML

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